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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 067183/0192

Applicant: Tomoyuki YORINAGA et al.

Title: ASYNCHRONOUS TRANSFER MODE SWITCH

Serial No. 09/929,367

Filed: August 15, 2001

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Examiner: Unknown

Technology Center 2600

Art Unit: 2661

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO-SB/08 is a listing of documents known to Applicants in order to comply with Applicants' duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicants do not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

CERTIFICATION

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

RELEVANCE OF EACH DOCUMENT

A translation of a portion of a Chinese Office Action that issued June 6, 2003 with respect to a counterpart Chinese patent application is provided below.

"This application relates to an asynchronous transfer mode switch. Through examination, the following examination opinions are now provided:

1. Claim 1 claims an ATM switch, which belongs to a product claim, and its technical features "each of said output side...interfaces; each of said input side...virtual path; each of said output side...virtual path" belong to statements about method and

step, not structural features. The product claim 1 actually merely discloses three composite parts: one or more input side circuit interfaces, one or more output side circuit interfaces and an ATM core switch.

Ref. 1 discloses an ATM switch for flow control, wherein the following technical features are disclosed (see page 2, lines 3-16, page 7, lines 14-15, Figs. 1, 2 of the description in ref. 1): the switch includes at least one input port, at least one output port (see page 2, lines 5-7 of the description in ref. 1); an NxN switch fabric (see page 7, lines 14-15 of the description in ref. 1), which is equivalent to the core switch of the invention. Thus, ref. 1 has disclosed all technical features of the parts of the product claim. The technical solution disclosed in ref. 1 and that claimed in the claim belong to the same technical field and can produce the same technical effects. Thus, claim 1 is not in conformity with the provision on novelty of Art. 22, para. 2 of the Patent Law.

2. Claim 2 further defines claim 1 which it refers to, its additional technical features have been disclosed in ref. 1 (see page 2, lines 3-16 of the description, page 11, lines 27-29, Figs. 1, 2 of the description in ref. 1): the input side includes an input port for receiving cells (equivalent to the physical layer processing section of the invention) and input buffers, receiving the cells inputted from the input port and control the flow according to the feedback message transmitted from the output port (equivalent to the parts which fulfils the cell rate control function of the invention). Thus, when claim 1 it refers to has no novelty, claim 2 is not in conformity with the provision on novelty of Art. 22, para. 2 of the Patent Law.

3. Claim 3 further defines claim 2 which it refers to. Ref 1 discloses (see page 2, lines 3-16, page 8, lines 12-24, Figs. 1, 2 of the description in ref. 1) that the output side includes the output buffers (equivalent to the output virtual path cell rate control section of the invention) and the output port (equivalent to the physical layer section of the invention). When the output buffers become filled to the threshold level, the feedback message is transmitted to the input buffers to prevent transmission of cells from the input buffers (see page 8, lines 12-24 of the description in ref. 1). By combining the publicly-known general knowledge of the field, those skilled in the art can know that in order to determine whether the output buffers are filled to the threshold level, real time monitoring must be conducted to the storage amount in the output buffers, so as to determine the actual storage amount, and the cell number actually stored in the output buffers can be stored

on a physical device, which is equivalent to the output virtual channel cell rate control section of the invention. Thus, it is obvious to those skilled in the art to obtain the technical solution of claim 3 on the basis of ref. 1 and in combination with the publicly-known general knowledge of the field, and no unexpected technical effects are produced. Thus, claim 3 is not in conformity with the provision on inventiveness of Art. 22, para. 3 of the Patent Law.

4. Claim 4 further defines claim 1 which it refers to, its additional technical features have been disclosed in ref. 2 (see the abstract, Fig. 1 of ref. 2): the switch includes multiplexing means (see drawing ref. sign 51 of Fig. 1 in ref. 2) for multiplexing the input signals; address filters (see drawing ref. signs 52-1, 52-M of Fig. 1 in ref. 2); output port buffers, which is equivalent to the cell buffers of the invention. Besides, using a buffer of the first-in first-out type is the publicly-known general knowledge of those skilled in the art. Thus, it is obvious to those skilled in the art to obtain the technical solution of claim 4 on the basis of refs. 1 and 2 and in combination with the publicly-known general knowledge of the field, and no unexpected technical effects are produced. Thus, claim 4 is not in conformity with the provision on inventiveness of Art. 22, para. 3 of the Patent Law.

5. Claims 5, 6 further define claims 2, 3 which they refer to, the additional technical features further define the contents of storage, not on the structural features of product, thus resulting in the protection scopes of the claims unclear, which is not in conformity with the provision of Rule 20, para. 1 of the Implementing Regulations of the Patent Law.

For the above reasons, no patent right can be granted for this application on the basis of the current text. The amendment made to the application documents by the applicant shall conform with the provision of Art. 33 of the Patent Law and shall not go beyond the scope of the disclosure contained in the initial description and claims. If the applicant cannot state sufficient reasons why this application has novelty and inventiveness within the time limit for response specified in this Office Action, then this application will be rejected."

Applicant's statements regarding the Chinese Office Action is based on a partial translation that Applicant's representative obtained. This statement should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Chinese Office Action.

Applicants respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

September 5, 2003

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Substitute for form 1449B/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT		Application Number	09/929,367
Date Submitted: September 5, 2003 <i>(use as many sheets as necessary)</i>		Filing Date	08/15/2001
		First Named Inventor	Tomoyuki YORINAGA et al.
		Group Art Unit	2661
		Examiner Name	Unassigned
		Attorney Docket Number	067183-0192
Sheet	1	of	1

U.S. PATENT DOCUMENTS

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FOREIGN PATENT DOCUMENTS

NON PATENT LITERATURE DOCUMENTS

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

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